



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

KD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/417,479 10/13/99 MCCAFFERTY

J 2811/32729C

EXAMINER

HM12/0626

FLEHR HOHSACH TEST
ALBRITTON & HERBERT
FOUR EMBARCADERO CENTER SUITE 3400
SAN FRANCISCO CA 94111

PONNALLURI, P

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

06/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1. The first step in the process is to identify the problem or issue that needs to be addressed. This involves gathering information and understanding the context of the problem.

2. Once the problem is identified, the next step is to define the objectives and goals of the project. This helps to clarify what needs to be achieved and provides a clear direction for the team.

3. The third step is to develop a plan or strategy to address the problem. This involves breaking down the problem into smaller, manageable tasks and determining the resources needed to complete them.

4. The fourth step is to implement the plan. This involves putting the strategy into action and monitoring progress regularly to ensure that the project is on track.

5. The final step is to evaluate the results of the project. This involves assessing the outcomes against the objectives and goals and identifying any areas for improvement.

Part of Paper No. 6

Art Unit: 1627

1. The preliminary amendment filed on 10/13/99 has been fully considered and entered into the application.
2. New claims 44-53 have been added and claims 1-43 have been canceled by the amendment filed on 10/13/99.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 44-46, drawn to a filamentous bacteriophage, classified in class 935, subclass 22.
 - II. Claims 47-51, drawn to a phagemid comprising a DNA encoding a single-chain antibody-coliphage pIII fusion protein, a process of producing a phagemid, classified in class 935, subclass 58.
 - III. Claim 52, drawn to a method of selecting antibody from an antibody library, classified in class 435, subclass 5.
 - IV. Claim 53, drawn to a method of presenting a peptide or protein at the surface of a phagemid viral particle, classified in class 435, subclass 5.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

Art Unit: 1627

instant case the different inventions of group I inventions are drawn to filamentous bacteriophage particle which is different from the phagemid of group II inventions.

5. Inventions of group II and groups III, IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (group II inventions) can be used in different process such as the group III or group IV inventions.

6. Inventions of group I and groups III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group I are different, and are not required to practice groups III and IV inventions.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1627

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.11(i).

10. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



P. Ponnaluri
Patent Examiner
Technology Center 1600
Art Unit 1627
19 June 2000